

REMARKS

Reconsideration is respectfully requested.

CLAIM OBJECTIONS

The Examiner has objected to Claim 13 for including an intangible object as a claim limitation. Applicant has amended Claim 13 to clarify and correct Claim 13.

35 USC §112, 2ND PARAGRAPH

The Examiner has rejected Claim 13, under 35 USC §112, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has stated it is unclear whether Applicant is claiming a product or a method in Claim 13. Applicant submits that a system is not necessarily a product, and that a system can be a method (as in the present case). However, Applicant has amended Claim 13 to further clarify that Claim 13 is a method and not a product. It is therefore respectfully submitted that rejection of this Claim should be withdrawn.

35 USC §102

The Examiner has rejected Claims 1-2, 6-8, 9-11, 12-20, 26, and 30 under 35 USC §102, as allegedly being anticipated by Kesler (US 4,470,373).

On page 3, line 11, of the office action the Examiner states: "Kesler discloses a dally training system..." Applicant respectfully submits that the Examiner is mistaken. The Kesler device is NOT a dally training system, and CANNOT function as a dally training system. As Applicant's specification clearly teaches, dallying is the act of quickly wrapping the free end of a dally rope around a saddle horn. A device will NOT function as a dally training system unless the dally rope can be wrapped around the saddle horn. The Kesler device cannot be used as a dally training system since there is no free end of dally rope for wrapping around the saddle horn. The Kesler device does not teach dallying and is incapable of being used for dallying.

Further, on page 4, line 1-2, of the office action the Examiner refers to the Kesler reference and states: "The step of dallying, as required by claim 13, is described in col. 3, lines 36-51." Once again Applicant respectfully submits that the Examiner is mistaken, and that col. 3, lines 36-51 of the Kesler reference do NOT teach dallying (which is wrapping the rope around the saddle horn as described in Applicant's specification). The teachings of the Kesler reference do NOT involve dallying.

Applicant has amended Claim 1, Claim 7, Claim 14, and Claim 26 to even more clearly distinguish Applicant's invention from the prior art. The following limitation has been added to Claim 1, Claim 7, Claim 14, and Claim 26: "wherein said at least one dally rope is structured and arranged to permit dallying around the at least one saddle horn". The Kesler device does NOT teach at least one dally rope structured and arranged to permit

dallying around the at least one saddle horn. Therefore the Kesler device does not teach all of the elements of Applicant's Claim. It is therefore respectfully submitted that rejection of Claim 1 (and all Claims dependent therefrom), Claim 7 (and all Claims dependent therefrom), Claim 14 (and all Claims dependent therefrom), and Claim 26 (and all Claims dependent therefrom) should be withdrawn.

Further, Applicant's Claims 1-6 are means-plus-function claims.

The Federal Circuit has stated:

Per our holding, the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

Applicant respectfully submits that the Kesler reference clearly does NOT teach structures equivalent to the structures disclosed in Applicant's specification and drawings for Applicant's claim elements.

Further, regarding Claim 13: The Kesler reference does NOT teach Applicant's element e) which involves dallying. As mentioned above the Kesler device does not teach dallying and is incapable of being used for dallying. Thus, the Examiner has failed to establish a *prima facie* case for anticipation of Claim 13.

The Examiner has rejected Claims 14-16 under 35 USC §102, as allegedly being anticipated by Rudolph (US 2,821,960).

On page 4, line 4, of the office action the Examiner states: "Rudolph discloses a dally training system..." Applicant respectfully submits that the Examiner is mistaken. The Rudolph device is NOT a dally training system, and CANNOT function as a dally training system. As Applicant's specification clearly teaches, dallying is the act of quickly wrapping the free end of a dally rope around a saddle horn. A device will NOT function as a dally training system unless the dally rope can be wrapped around the saddle horn. The Rudolph device cannot be used as a dally training system since there is no free end of dally rope for wrapping around the saddle horn. The Rudolph device does not teach dallying and is incapable of being used for dallying.

Applicant has amended Claim 14 to even more clearly distinguish Applicant's invention from the prior art. The following limitation has been added to Claim 14: "wherein said at least one dally rope is structured and arranged to permit dallying around the at least one saddle horn". The Rudolph device does NOT teach at least one dally rope structured and arranged to permit dallying around the at least one saddle horn. Therefore the Rudolph device does not teach all of the elements of Applicant's Claim. It is therefore respectfully submitted that rejection of Claim 14 (and all Claims dependent therefrom) should be withdrawn.

Applicant believes that all Claims, as amended, are now allowable with respect to 35 USC §102 and respectfully request that all such rejections be withdrawn.

35 USC §103

The Examiner has rejected Claims 3-5 under 35 USC §103, as allegedly being unpatentable over Kesler (US 4,470,373) in view of Fontaine (US 2,776,644).

Applicant repeats as though fully set forth here the above arguments regarding the Kesler reference. Further, the Kesler device is unrelated to dallying and it would not be obvious to combine the Kesler device with other references to construct a dally practicing device. The Fontaine reference is also unrelated to a dally practice system and it would NOT be obvious to combine the Fontaine reference with the Kesler reference.

The Federal Circuit has enunciated several guidelines in making a §103 obviousness determination. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)). (Emphasis added). For the Examiner to establish a prima facie case of obviousness, the Examiner must contend that the teachings from the prior art *itself* or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

It is well settled that to support an obviousness rejection, the prior art must contain some teaching or suggestion to make the modifications suggested by the Examiner. In this regard, the Federal Circuit has stated that "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (emphasis added) *In re Frisch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.) Applicant respectfully submits that no such suggestion exists in the Kesler reference or the Fontaine reference to so modify or combine the elements to result in the Applicant's claimed invention. Furthermore, Applicant respectfully submits again that neither the Kesler nor the Fontaine references teach nor suggest Applicant's claimed invention.

The Kessler and Fontaine references are non-analogous art. The Kessler and Fontaine references are in a different class than Applicant's invention. Applicant's invention should be classified in 434/247 (education and demonstration/physical education). Applicant's device does not involve live animals, as do the Kessler and Fontaine devices. The Kessler and Fontaine are designed to control animals, whereas Applicant's device is designed to assist in training people. Since the Kessler and Fontaine references are non-analogous art, obvious rejections based on these references are improper. It is therefore respectfully submitted that rejection of Claims 3-5 (and all Claims dependent therefrom) should be withdrawn.

Further, Applicant respectfully submits that the Examiner has provided no evidence of motivation or suggestion to combine the references as suggested by the Examiner. Applicant

respectfully submits that the Examiner has not made a *prima facie* case of obviousness for the elements of these Claims. It is therefore respectfully submitted that rejection of Claims 3-5 (and all Claims dependent therefrom) should be withdrawn. If the Examiner persists with these rejections, Applicant requests evidence of motivation or suggestion to combine the references as suggested by the Examiner. But, even if such motivation were found such combination would still not result in Applicant's invention as claimed. For Example: the end of the Fontaine device is not a dallying rope and is NOT suitable for dallying.

The Examiner has rejected Claim 21 under 35 USC §103, as allegedly being unpatentable over Kesler (US 4,470,373) in view of Marshall (US 3,123,052).

Once again, the Kessler and Marshall references are non-analogous art. The Marshall reference is in a different class than Applicant's invention. Applicant's invention should be classified in 434/247 (education and demonstration/physical education). Applicant's device does not involve live animals, as does the Marshall device. The Marshall device is designed to control animals, whereas Applicant's device is designed to assist in training people. Since the Kessler and Marshall references are non-analogous art, obvious rejections based on these references are improper. It is therefore respectfully submitted that rejection of Claim 21 (and all Claims dependent therefrom) should be withdrawn.

Further, Applicant respectfully submits that the Examiner has provided no evidence of motivation or suggestion to combine the references as suggested by the Examiner. Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness for the elements of these Claims. It is therefore respectfully submitted that rejection of Claim 21 (and all Claims dependent therefrom) should be withdrawn. If the Examiner persists with these rejections, Applicant requests evidence of motivation or suggestion to combine the references as suggested by the Examiner. But, even if such motivation were found such combination would still not result in Applicant's invention as claimed. For Example: the end of the Marshall device is not a dallying rope and is NOT suitable for dallying.

Applicant respectfully submits that the Federal Circuit has stated: "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.)

The Examiner has rejected Claims 22-23 under 35 USC §103, as allegedly being unpatentable over Kesler (US 4,470,373) in view of Bacque (US 6,000,989).

Former Chief Judge Markey of the Federal Circuit has stated, "virtually all inventions are 'combinations', and ... every invention is formed of 'old elements' ... Only God works from nothing. Man must work with the elements." H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983).

Once again, the Bacque reference is non-analogous art. The Bacque reference is in a different class than Applicant's invention. Applicant's invention should be classified as in 434/247 (education and demonstration/physical education), whereas the Bacque device is a toy which is unrelated to dallying. Since the Kessler and Bacque references are non-analogous art, obvious rejections based on these references are improper. It is therefore respectfully submitted that rejection of Claims 22-23 (and all Claims dependent therefrom) should be withdrawn.

The safety release of the Bacque reference functions in an entirely different manner than Applicant's. The Bacque device has a noose which is broken by the safety release. Applicant's device does not comprise a safety release for a noose. It would NOT be obvious to combine the safety release of the Bacque device with the Kesler device.

Once again, Applicant respectfully submits that the Examiner has provided no evidence of motivation or suggestion to combine the references as suggested by the Examiner. Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness for the elements of these Claims. It is therefore respectfully submitted that rejection of Claims 22-23 (and all Claims dependent therefrom) should be withdrawn. If the Examiner persists with these rejections, Applicant requests evidence of motivation or suggestion to combine the references as suggested by the Examiner.

The Examiner has rejected Claims 22, 24-25 and 31-33 under 35 USC §103, as allegedly being unpatentable over Kesler (US 4,470,373) in view of Knox (US 2,563,533).

The Knox reference is non-analogous art. The Knox reference is in a different class than Applicant's invention. Applicant's invention should be classified as in 434/247 (education and demonstration/physical education), whereas the Knox device is a toy which is unrelated to dallying. Since the Kessler and Knox references are non-analogous art, obvious rejections based on these references are improper. It is therefore respectfully submitted that rejection of Claims 22, 24-25 and 31-33 (and all Claims dependent therefrom) should be withdrawn.

Once again, Applicant respectfully submits that the Examiner has provided no evidence of motivation or suggestion to combine the references as suggested by the Examiner. Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness for the elements of these Claims. It is therefore respectfully submitted that rejection of Claims 22, 24-25 and 31-33 (and all Claims dependent therefrom) should be withdrawn. If the Examiner persists with these rejections, Applicant requests evidence of motivation or suggestion to combine the references as suggested by the Examiner.

The Examiner has rejected Claims 27-29 under 35 USC §103, as allegedly being unpatentable over Kesler (US 4,470,373) in view of Croce et al. (US 3,853,283).

The Croce reference is non-analogous art. The Croce reference is in a different class than Applicant's invention. Applicant's invention should be classified in 434/247 (education and demonstration/physical education). Applicant's device does not involve live animals, as does the Croce device. The Croce device is designed to control animals, whereas Applicant's device is

designed to assist in training people. Since the Kessler and Croce references are non-analogous art, obvious rejections based on these references are improper. It is therefore respectfully submitted that rejection of Claim 27-29 (and all Claims dependent therefrom) should be withdrawn.

Once again, Applicant respectfully submits that the Examiner has provided no evidence of motivation or suggestion to combine the references as suggested by the Examiner. Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness for the elements of these Claims. It is therefore respectfully submitted that rejection of Claims 27-29 (and all Claims dependent therefrom) should be withdrawn. If the Examiner persists with these rejections, Applicant requests evidence of motivation or suggestion to combine the references as suggested by the Examiner. Applicant respectfully points out per MPEP § 2141 "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Further, regarding the Croce device, the Croce device does NOT teach Applicant's claim limitations as suggested by the Examiner. The "teeth" taught by the Croce device do NOT teach applicants claim limitation "wherein said at least one reel comprises at least one eccentric portion adapted to provide irregular retraction of said at least one line." The Examiner's statement on page 7, lines 5-6 of the office action that "it is considered that the lock settings encompasses 'irregular retraction'" is clearly NOT how "irregular retraction" is defined, described and taught in Applicant's specification- see page 15, lines 8-22, of Applicant's specification:

"Preferably, reel 114 comprises an asymmetric protrusion 115 (such as, for example, as shown in FIG. 7 and FIG. 8) so that reel 114 is eccentric and the speed with which slack is taken up and/or the tension in line 112 varies as the line is coiled around reel 114, thereby assisting in the simulation of an animal on the end of a rope (embodiment herein wherein said reel means comprises eccentric means for providing irregular retraction of said line means for improved simulation of the movement of an animal; and embodying herein wherein said eccentric means comprises at least one protrusion; and embodying herein wherein said eccentric means comprises exactly one protrusion; and embodying herein wherein said at least one reel comprises at least one eccentric portion adapted to provide irregular retraction of said at least one retractable line)."

It is therefore respectfully submitted that rejection of Claim 27-29 (and all Claims dependent therefrom) should be withdrawn.

For the reasons given above, and after careful review of all the cited references, Applicant respectfully submits that none of the cited references nor any combination of the cited references will result in Applicant's claimed invention in the present Claims, as amended. But even if any such combination might arguably result in such claimed invention, it is submitted that such combination would be non-obvious and patentable.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 50-1887.

Applicant respectfully requests that the Examiner, after having an opportunity to review this Office Action Response, grant a telephonic interview to Applicant's undersigned agent in order to discuss Applicant's response to the Examiner's first Office Action (before the Examiner prepares a second office action), to attempt to reach mutual understanding and clarify any outstanding issues. Applicant respectfully requests that the Examiner call Applicant's undersigned agent at 602-263-9200 to schedule a telephonic interview at least two business days in advance to allow the Applicant's undersigned agent time to prepare and schedule the interview. For telephonic scheduling purposes, Applicant's agent is located in Arizona, in the Mountain Standard Time zone.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to the Patent and Trademark Office fax number (571)-273-8300 on July 27, 2005.

Date 7/27/05

Signature:



Benjamin K. Erlick, Agent for Appl.